

JUL 14 2006

Application No. 09/386,775
Reply to Office Action of April 17, 2006

Docket No.: 00-VE13.51RCE1

REMARKS

The Office Action dated April 17, 2006 has been carefully reviewed and the following remarks are made in consequence thereof. Claim 16 has been amended. Claims 1-18 are pending. The Examiner rejected claims 1-18 under 35 U.S.C. §103(a). Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

Claim Rejections Under 35 USC §103(a)

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art ("AAPA") in view of U.S. Patent No. 5,550,901 to Williams ("Williams"). The rejections are respectfully traversed.

I. The Law

The basic requirements for the Patent and Trademark Office to meet its burden of establishing *prima facie* obviousness are as follows:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1966).

Further, as the Federal Circuit has stated, "[i]f identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed. Cir. 1998). "Rejecting patents solely by finding prior art

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corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Id.* (quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). Indeed, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

II. Claim 1

The Examiner conceded that the AAPA does not disclose "placing a frequency-selective filter in parallel with the local loop generation mechanism to provide a bypass path across the local loop generation mechanism," as recited in claim 1. (See the Office Action, Page 3). The Examiner relies upon Williams to allegedly teach this feature. However, Williams does not cure the deficiency of the AAPA.

Claim 1 recites in part:

placing a local loop generation mechanism in series with a communications path between the central office and the customer;

placing a frequency-selective filter in parallel with the local loop generation mechanism to provide a bypass path across the local loop generation mechanism.

(Emphasis added).

The Examiner states that Williams shows a frequency-selective filter in parallel with the local loop generation mechanism:

The band-reject filter 33 is a passive LC network and capacitor C6, as shown in figure 2, [is] connected parallel with the links 22 and 25 as shown in figure 1, wherein the links 22 and 25 read on the local loop generation mechanism in series with a communications path (i.e., in series

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with local loop 12 and telephone loop 14) between the central office and the customer.

(See the Office Action, Page 3).

Applicant believes the Examiner has misread Williams. Williams shows a filter 33 in series with a local loop, the local loop being shown between PBX telephone 26 and telephone 42. (See Williams; FIG. 1; Col. 4, Lines 11-15). Therefore, Williams discloses a filter in series with a local loop rather than “in parallel with the local loop,” as claim 1 recites. Thus, Williams does not meet the burden of a prima facie case requiring all elements. For at least this reason, claim 1 is allowable over the cited prior art.

III. Claims 2 and 16 – 18

Independent claims 2 and 17-18 all recite a frequency-selective filter placed in parallel with a local loop generation mechanism. Independent claim 16 recites placing a frequency selective filter in parallel with the communications path. As set forth above, neither the AAPA nor Williams discloses the parallel claim element. Therefore, claims 2 and 16-18 are allowable over the cited prior art.

IV. Claims 3 – 15

Claims 3-15 all depend, directly or indirectly, from claim 2. Therefore, claims 3-15 are allowable as being dependent from allowable claim 2. Moreover, as shown by way of example below, the claims contain independently patentable elements.

Additionally, the Examiner states that “[r]egarding claims 3-15, the obvious combination of the AAPA and the Williams [reference] teach and render the limitations of the claims.” (See the Office Action, Page 4). However, the Examiner fails to apply particular sections of the reference against each of those limitations. If the Examiner intends to maintain this rejection, Applicants respectfully request that the Examiner identify passages in the reference in the next office action which, in his view, allegedly read on the limitations in these claims, or otherwise withdraw the rejection.

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a. Claim 4

Claim 4 recites in part:

wherein the frequency selective filter is a high-pass filter.

(Emphasis added).

Williams teaches a band-reject filter 33. (See Williams; FIG. 1; Col. 4, Lines 21-31). A band-reject filter is not a "high-pass filter," as claim 4 recites. Therefore, Williams and AAPA do not show each and every element of claim 4. Thus, the 35 U.S.C. §103(a) rejection of claim 4 should be withdrawn and the claim allowed. Claim 4 is in condition for allowance.

b. Claim 5

Claim 5 recites in part:

wherein the frequency selective filter is a bandpass filter.

(Emphasis added).

Williams teaches a band-reject filter 33. (See Williams; FIG. 1; Col. 4, Lines 21-31). A band-reject filter is not a "bandpass filter," as claim 5 recites. Therefore, Williams and AAPA do not show each and every element of claim 5. Thus, the 35 U.S.C. §103(a) rejection of claim 5 should be withdrawn and the claim allowed. Claim 5 is in condition for allowance.

c. Claim 8

Claim 8 recites in part:

wherein the RJ71C terminal block is organized into a first portion and a second portion, the first portion providing one or more connections to the customer premises and the second portion providing one or more connections to the central office.

Neither Williams nor AAPA teach at least these claim limitations. Thus, the 35 U.S.C. §103(a) rejection of claim 8 should be withdrawn and the claim allowed. Claim 8 is in condition for allowance.

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d. Claim 9

Claim 9 recites in part:

wherein the frequency selective filter is connected across the first and second portions of the RJ71C terminal block.

(Emphasis added).

Neither Williams nor AAPA teach at least these claim limitations. Thus, the 35 U.S.C. §103(a) rejection of claim 9 should be withdrawn and the claim allowed. Claim 9 is in condition for allowance.

e. Claim 15

Claim 15 recites in part:

wherein the frequency selective filter is provided in the form of a high-pass and/or bandpass filter.

(Emphasis added).

Neither Williams nor AAPA teach at least these claim limitations, as explained above in detail with respect to high-pass and bandpass filters. Thus, the 35 U.S.C. §103(a) rejection of claim 15 should be withdrawn and the claim allowed. Claim 15 is in condition for allowance.

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CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0129. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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